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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/454,173	12/02/1999	LINDA B. VANDERWOLD	3179.01A	3447

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EXAMINER

HAN, QI

ART UNIT PAPER NUMBER

2626

DATE MAILED: 08/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/454,173	Applicant(s) VANDERWOLD ET AL.	
	Examiner Qi Han	Art Unit 2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 49-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 49-63 is/are rejected.
- 7) ☒ Claim(s) 62 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>12/02/1999</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Information Disclosure Statement

1. The references listed in the Information Disclosure Statement submitted on 12/02/1999 have been considered by the examiner (see attached PTO-1449).

Election/Restrictions

2. Applicant's election without traverse of invention Group II (claims 49-63) in the reply filed on 09/27/2004 is acknowledged (page 1).

Specification

3. The disclosure is objected to because of the following:
 - a. on page 20, lines 3-8, it first says "one subroutine 114 comprise **replacing** the word...**with the verb form of the "ing" word...**", while at the same paragraph, it also says "running subroutine 114 **removes boring "ing" words** and results in use of stronger verbs", which are confused from or contrary to each other. Appropriate correction/clarification is required.
 - b. on page 21, lines 3-5, the meaning of content "to collapse the object of the preposition in **each phrase** to an adjective, and to place that adjective in front of **the** subject" is unclear, since the recited terms lack clear antecedent basis in the context. Appropriate correction/clarification is required.

Claim Objections

4. Claim 62 is objected to because of the following informalities:

Regarding claim 62 is uncompleted. Appropriate correction is required. The claim will be interpreted as “The method of claim 49, further including the step of referring to a verb lookup list” hereinafter.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 49-63 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claim 49, it recites “a method for editing a text document, comprising the steps of: a. inputting a text document to a computer system; b. conducting error-correcting functions to achieve clarity, conciseness and reader comfort; and, c. displaying said text document in a corrected form”, which is broadly interpreted as method of only manipulating abstract idea and/or pure data, so that it is directed to non-statutory subject matter (See MPEP 2106). Even though the claim includes “inputting a text document to a computer” and “displaying” the “corrected text document”, the claim is still substantially in the nature of manipulating or arranging abstract idea and/or pure data.

Regarding claims 50-62, the rejection is based on the same reason as described for claim 49, because the claims only recite further limitation of manipulating or arranging abstract idea and/or pure data. In addition, it is noted that the claimed content terms, such as “responsible”,

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“It”, and “There”, are merely non-functional descriptive material, which are also non-statutory subject matter.

Regarding claim 63, the rejection is based on the same reason as described for claim 49, because the claim recites the same or similar limitation as claim 49.

6. To expedite a complete examination of the instant application the claims rejection under 35 U.S.C 101 (nonstatutory) above are further rejected as set forth below in anticipation of applicant amending these claims to place them within the four statutory categories of invention.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 49-63 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 49, the limitation “**to achieve clarity, conciseness and reader comfort**” is indefinite, because the specification does not clearly define the claimed terms. Further, it is noted that without clear definition, these terms are highly subjective and uncertain.

Regarding claim 50-63, the rejection is based on the same reason described for claim 53, because the claims include the same or similar problematic limitation(s) as claim 53.

In addition, claim 50 recites the limitation “**the** word “responsible” ” and “**the** verb form”. There is insufficient antecedent basis for the limitation in the claim(s). Further, as stated

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above, the word “responsible” is non-functional descriptive material and nonstatutory subject matter, so that it has no patentable weight.

In addition, claim 51 recites the limitation "**the** word “It” " in the first line of the claim. There is insufficient antecedent basis for this limitation in the claim. Further, as stated above, the word “It” is non-functional descriptive material and nonstatutory subject matter, so that it has no patentable weight.

In addition, claim 52 recites the limitation "**the** word “There” " in the first line of the claim. There is insufficient antecedent basis for this limitation in the claim. Further, as stated above, the word “There” is non-functional descriptive material and nonstatutory subject matter, so that it has no patentable weight.

In addition, regarding claim 53, the limitation of “three or more prepositions **in a raw**” is not clearly defined, because the prepositional phrases of a sentence in a raw vary, depending on length of the raw, fond of the letters, position of the sentence in the context. Therefore, the limitation “in a raw” is a relative/uncertain measure, so as being indefinite.

In addition, regarding claim 54, the rejection is based on the same reason described for claim 53, because the claim recites the same or similar problematic limitation(s) as claim 53.

In addition, regarding claim 55, the rejection is based on the same reason described for claim 53, because the claim recites the same or similar problematic limitation(s) as claim 53. Further, the limitation “**attempting** to collapse ...” is vague, because it is unclear whether the collapsing is a necessary processing step, or just an optional feature.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 53-63 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claim 53, the claim limitation “when said sentence includes three or more prepositional phrases in a row, said error-correcting functions comprise moving a prepositional phrase to the beginning of a sentence” has an enablement problem, because not every sentence having three or more repetition phrases in a row can be re-ordered by moving a prepositional phrase to the beginning of a sentence”. For example, if the sentence of “the government of the people, by the people, for the people, shall not perish from the earth” were applied to the claimed feature, it would be no sense. It is noted that correctly moving a preposition position or order in a sentence not only relies on syntactic/grammatical structure rules, but also needs to provide the meaningful/semantic knowledge, but the applicant fails to do so. It also noted that without disclosing complete or more specific syntax and semantic rules/criteria the claimed error-correcting functions couldn’t work or complete in a normal operation. Therefore, the claimed subject matter is not described in the specification in such a way as to enable one skilled in the art to make and/or use the invention, without undue experimentation.

Regarding claim 54, the rejection is based on the same reason described for claim 53, because the rejection for claim 53 covers the same or similar problematic limitation(s) as claim

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54, wherein the phrase “from the earth” in the exemplary sentence is read on claimed “location-expressing prepositional phrase” as claimed.

Regarding claim 55, the rejection is based on the same reason described for claim 53, because the rejection for claim 53 covers the same or similar problematic limitation(s) as claim 54.

Regarding claims 56-57, the rejection is based on the same reason described for claim 53, because the rejection for claim 53 covers the same or similar problematic limitation(s) as claim 54, wherein the claimed replacing process not only relies on syntactic/grammatical structure rules, but also needs to provide meaningful/semantic knowledge, but the applicant fails to disclose complete or specific rules/criteria for the claimed functions in order to correctly work in normal operations.

Regarding claims 58-61, the rejection is based on the same reason described for claim 53, because the rejection for claim 53 covers the same or similar problematic limitation(s) as claim 58 (see rationale for claim 53 above).

Regarding claim 63, it recites “apparatus capable of carrying out the method of claim 49”. The claim is treated as a single means claim, because the claim only recites a single structural element--apparatus itself, for achieving the stated property, no any other structural elements at all. It is noted that single means claim is subject to an undue breadth rejection under 35 USC 112 1st (see MPEP 2164.08(a)).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 49 and 63 are rejected under 35 U.S.C. 102(e) as being anticipated by LEWIS et al. (US 2002/0002459 A1) hereinafter referenced as LEWIS.

As per **claim 49**, as best understood in view of the claim rejection under 35 USC 101 and 112 2nd (see above), LEWIS discloses ‘method and system for proofreading and correcting dictated text’ (title), comprising:

“a. inputting a text document to a computer system” (paragraph (hereinafter referenced as p) 7, ‘text input’; Fig. 1 and p36, ‘a typical computer system’);

“b. conducting error-correcting functions [to achieve clarity, conciseness and reader comfort]’ (p 9, ‘proofread and correct dictated text’, ‘selecting proofreading criteria for identifying textual errors’); and,

“c. displaying said text document in a corrected form” (Fig.3G and p 11, ‘highlighting each the word contained in the electronic document’ ‘visually displaying each the highlighted word in the user interface’; p 13, ‘editing each the marked textural error’, ‘display the recommended change’, which necessarily or inherently include displaying the text document in a corrected form).

As per **claim 63**, it recites an apparatus. As best understood in view of the claim rejection under 35 USC 101 and 112 1st (see above), the rejection is based on the same reason described for claim 49, because the claim includes the same or similar limitation(s) as claim 49.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 50-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over LEWIS.

As per **claim 50** (depending on claim 49), LEWIS does not exactly disclose that “when the word “It” starts a sentence, said error-correcting functions comprise replacing the word “It” with words describing to whom or to what “It” refers”. However, as best understood in view of the claim rejection under 35 USC 101 and 112 2nd (see above), the feature of replacing word or phrase is well known in the art as evidenced by LEWIS himself who further discloses ‘proofreading options interface’ and ‘the replacement of the highlighted text with the suggested text’ (p 57-58), which suggests that the system has capability of implementing functionality as claimed. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to recognize LEWIS’s system can replace a text with a selected text, including word, phrase, or other portion of the text, through proofreading interface, as taught by LEWIS himself, for the purpose (motivation) of accepting a user specified preference (abstract).

In addition, it is noted that in the realistic practice, the claimed feature highly depends on the interactive and/or subjective actions, so that LEWIS's system providing functionalities of editing, correcting, replacing, suggesting and displaying in an interactive manner, satisfies the implementation of the claimed features.

As per **claim 51** (depending on claim 49), the rejection is based on the same reason described for claim 50, because the rejection for claim 50 covers the same or similar limitation(s) as claim 51.

As per **claim 52** (depending on claim 49), the rejection is based on the same reason described for claim 50, because the rejection for claim 50 covers the same or similar limitation(s) as claim 52, wherein 'proofreading criteria' can be used for the claimed steps.

11. Claims 53-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over LEWIS in view of SARAKI et al. (US 5,903,858).

As per **claim 53** (depending on claim 49), LEWIS does not expressly disclose that "when said sentence includes three or more prepositional phrases in a row, said error-correcting functions comprise moving a prepositional phrase to the beginning of a sentence". However, as best understood in view of the claim rejection under 35 USC 101, 112 1st and 2nd (see above), the feature of moving prepositional phrase to a different position including the beginning of a sentence, is well known in the art as evidenced by SARAKI who discloses 'translation machine for editing an original text by rewriting the same and translating the rewrote one' (title), comprising multiple levels of analysis modules and 'rewriting rules' (col. 9-14), and teaches that 'the inserted adverbial clause (including prepositional phrase) is moved to the beginning of the

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sentence’ and ‘the word order of ...the preposition phrase is changed’ (col. 14, lines 29-34).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify LEWIS by providing changing the word order of a preposition phrase in a sentence, as taught by SARAHI, for the purpose (motivation) of rewriting or editing the text to a simple text based on rewriting rules (SARAHI: abstract).

As per **claim 54** (depending on claim 53), the rejection is based on the same reason described for claim 53, because the rejection for claim 53 covers the same or similar limitation(s) as claim 54, wherein the teaching that ‘the word order of ...the preposition phrase is changed’ (SARAHI: col. 14, lines 29-34) is applicable to move suitable “location-expressing prepositional phrase” as claimed.

As per **claim 55** (depending on claim 49), as best understood in view of the claim rejection under 35 USC 101, 112 1st and 2nd (see above), the rejection is based on the same reason described for claim 53, because the rejection for claim 53 covers the same or similar limitation(s) as claim 55. In addition, SARAHI discloses that using ‘the first aspect...’ replace ‘according to one aspect ...’ (SARAHI: col. 14, lines 57-61), which further suggests that the combined teachings provide capability of implementing functionality as claimed.

As per **claim 56** (depending on claim 49), LEWIS does not exactly disclose that “when a sentence includes both a weak verb and a gerund, said error-correcting functions comprise replacing said weak verb with the verb form of said gerund”. However, as best understood in view of the claim rejection under 35 USC 101, 112 1st and 2nd (see above), the feature of replacing said weak verb with the verb form of said gerund is well known in the art as evidenced by SARAHI who discloses ‘translation machine for editing an original text by rewriting the same

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and translating the rewrote one' (title), comprising multiple levels of analysis modules and 'rewriting rules' (col. 9-14), recognizing syntax component, such as 'gerund' and ing-form of verb, and providing the corresponding rewriting rules (col. 10, line 12 and col. 11, lines 28-47), which suggests that the system has capability of implementing functionality as claimed.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify LEWIS by providing analyzing sentence structure and rewriting rules, including processing gerund and ing-form of verbs, as taught by SARA KI, for the purpose (motivation) of rewriting or editing the text to a simple text based on a rewriting rule (SARA KI: abstract).

12. Claim 57 is rejected under 35 U.S.C. 103(a) as being unpatentable over LEWIS in view of SARA KI as applied to claim 56, and further in view of well known prior art (MPEP 2144.03).

As per **claim 57** (depending on claim 56), LEWIS in view of SARA KI does not expressly disclose "referring to a verb lookup list". However, an official notice is taken that the feature of providing referring to a lookup list of certain type of words (such as verbs) is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify LEWIS in view of SARA KI by providing referring to a lookup list of certain type of words, for the purpose (motivation) of allowing user to select a preferred or alternative word suggested in a list for editing and rewriting a text.

13. Claims 58-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over LEWIS in view of well known prior art (MPEP 2144.03).

As per **claim 58** (depending on claim 49), LEWIS does not expressly disclose “when a noun in a prepositional phrase interposed between a sentences subject and verb is capable of action, said error correcting functions comprise making said noun the subject of said sentence, and deriving a substitute verb from what said subject does”. However, as best understood in view of the claim rejection under 35 USC 101 and 112 1st (see above), an official notice is taken that the feature of rewriting a sentence based on certain grammatical and semantic knowledge by user in interactive manner is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify LEWIS by providing rewriting a sentence based on certain grammatical and semantic knowledge by user in interactive manner, for the purpose (motivation) of allowing user to edit or rewrite a text with preferred forms of word(s), phrase(s) or sentence without changing original meaning of the text.

As per **claim 59** (depending on claim 49), LEWIS does not expressly disclose “when a noun in a prepositional phrase interposed between a sentence's subject and verb is capable of action, said error correcting functions comprise making said noun the subject of said sentence, and deriving a substitute verb from what said subject does”. However, as best understood in view of the claim rejection under 35 USC 101 and 112 1st (see above), an official notice is taken that the feature of rewriting a sentence based on certain grammatical and semantic knowledge by user in interactive manner is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify LEWIS by providing rewriting a sentence based on certain grammatical and semantic knowledge by user in interactive manner, for the purpose (motivation) of allowing user to edit or rewrite a text with preferred forms of word(s), phrase(s) or sentence without changing original meaning of the text.

As per **claim 60** (depending on claim 59), LEWIS does not expressly disclose “referring to a transition lookup list”. However, an official notice is taken that the feature of providing referring to a lookup list of certain type of words (such as transition words) is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify LEWIS by providing referring to a lookup list of certain type of words, for the purpose (motivation) of allowing user to select a preferred or alternative word suggested in a list for editing and rewriting a text.

As per **claim 61** (depending on claim 49), LEWIS does not expressly disclose “when a sentence with a weak verb has an actor capable of action, said error-correcting functions comprise: i. replacing said sentence's subject with said action-capable actor; and, ii. replacing said weak verb with a strong verb”. However, as best understood in view of the claim rejection under 35 USC 101 and 112 1st (see above), an official notice is taken that the feature of rewriting a sentence based on certain grammatical and semantic knowledge by user in interactive manner is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify LEWIS by providing rewriting a sentence based on certain grammatical and semantic knowledge by user in interactive manner, for the purpose (motivation) of allowing user to edit or rewrite a text with preferred forms of word(s), phrase(s) or sentence without changing original meaning of the text.

As per **claim 62** (depending on claim 49), LEWIS does not expressly disclose “referring to a verb lookup list”. However, an official notice is taken that the feature of providing referring to a lookup list of certain type of words (such as verbs) is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to

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modify LEWIS by providing referring to a lookup list of certain type of words, for the purpose (motivation) of allowing user to select a preferred or alternative word suggested in a list for editing and rewriting a text.

Conclusion

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Qi Han whose telephone numbers is (571) 272-7604. The examiner can normally be reached on Monday through Thursday from 9:00 a.m. to 7:00 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richemond Dorvil, can be reached on (571) 272-7602.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Inquiries regarding the status of submissions relating to an application or questions on the Private PAIR system should be directed to the Electronic Business Center (EBC) at 866-217-9197 (toll-free) or 703-305-3028 between the hours of 6 a.m. and midnight Monday through Friday EST, or by e-mail at: ebc@uspto.gov. For general information about the PAIR system, see <http://pair-direct.uspto.gov>.

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RICHMOND DORVIL
SUPERVISORY PATENT EXAMINER